III. REMARKS / ARGUMENTS

A. Request for Withdrawal of Finality of Office Action

On page 9 of the Final Office Action, the Examiner indicated that the current Office Action is made final due to amendments made by the Applicant in the response to the previous Office Action (mailed September 22, 2004) which necessitated the new ground(s) of rejection presented in the current Office Action.

The Applicant respectfully disagrees with the Examiner and respectfully submits that the finality of the current Office Action is improper and should therefore be withdrawn.

Specifically, on pages 7 and 8 of the first Office Action (mailed September 22, 2004), the Examiner had rejected former dependent claim 6 under 35 USC 103(a) as being unpatentable over U.S. Patent 6,385,637 to Peters *et al.* (hereinafter referred to as "Peters") in view of U.S. Patent 6,757,897 to Shi *et al.* (hereinafter referred to as "Shi"). In paragraph 25 on page 8, the Examiner had indicated that Peters does not disclose features of former dependent claim 6, namely selecting an incomplete task on the basis of an expected duration for that task. In responding to the previous Office Action, claim 6 was amended to make it independent by incorporating features of its base claim (former claim 1) and the above-mentioned features, conceded by the Examiner to be absent from Peters, were shown to be also absent from Shi.

Now, on pages 2 and 8 of the current Final Office Action, the Examiner rejected claim 6 (now in independent form) as being anticipated by Peters. The Examiner contends that the above-mentioned features of claim 6, which the Examiner previously conceded as being absent from Peters, are now apparently disclosed by Peters. It is respectfully submitted that this complete contradiction and reversal in the Examiner's position cannot serve as a basis for "a new ground of rejection necessitated by the Applicant's

amendment of the claims". On the contrary, it is respectfully submitted that the new ground of rejection of claim 6 presented in the current Final Office Action is necessitated by *the Examiner's complete reversal in position regarding what is disclosed by Peters.*

Section 706.07(a) of the Manual of Patent Examining Procedure (MPEP) states that "[u]nder present practice, second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)".

Therefore, since the new ground of rejection presented in the current Final Office Action is due to the Examiner's complete reversal in position and is not necessitated by the Applicant's amendment of the claims (or based on information submitted in an information disclosure statement), it is respectfully submitted that the finality of the current Office Action is improper. The Examiner is thus respectfully requested to withdraw the finality of the current Office Action.

B. Summary of the Amendments

The specification has been amended in order to correct a minor typographical error detected by the Applicant upon reviewing the application.

Claims 23 to 26 have been cancelled without prejudice.

The application now contains twenty-three (23) claims, numbered 6, 8, 11, 13 to 22, and 32 to 41.

It is respectfully submitted that no new matter has been added by way of the present amendment.

C. Summary of Rejections and Reply

C.1 Rejection of claims 23 to 26 under 35 USC 112

On page 2 of the Final Office Action, the Examiner has rejected claims 23 to 26 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

It is respectfully submitted that this rejection is moot in view of the cancellation of claims 23 to 26.

C.2 Rejection of claims 6, 11, 13 to 18 and 20 under 35 USC 102

On page 2 of the Final Office Action, the Examiner has rejected claims 6, 11, 13 to 18 and 20 under 35 USC 102(e) as being anticipated by U.S. Patent 6,385,637 to Peters *et al.* (hereinafter referred to as "Peters").

As described below, the Applicant respectfully traverses this rejection and submits that claims 6, 11, 13 to 18 and 20 are in condition for allowance.

Independent claim 6

The Examiner's attention is respectfully directed to the following excerpt of claim 6, portions of which have been emphasized:

A method of executing a set of at least one incomplete task, comprising:

(a) selecting an incomplete task from the set on the basis of an expected duration for that task;

[...].

It is respectfully submitted that Peters does not disclose or suggest selecting an incomplete task from a set of at least one incomplete task on the basis of an expected duration for that task.

Specifically, Peters discloses allocating a "predetermined period of time *during which [a] selected process is permitted to execute*", i.e. the period of time *allocated* to execution of a process *after it has been selected* and before it is suspended (emphasis added, see col. 1, lines 35 to 43, and col. 9, lines 5 to 13).

Clearly, this has nothing to do with selecting an incomplete task on a basis of an expected duration for that task, for the following two reasons. Firstly, Peters' "period of time" allocated to execution of a task before its suspension is completely different from an expected duration of the task (i.e. the expected period of time needed for the task to reach completion), since in Peters the task will be suspended after the "period of time" regardless of whether it has reached completion. Secondly, notwithstanding that Peters' "period of time" in no way corresponds to an expected duration of a task, Peters' "period of time" is not used as a basis for selecting a task since it has meaning only *after a task has been selected*.

Accordingly, the Applicant respectfully submits that Peters does not disclose or suggest at least one feature of claim 6, namely selecting an incomplete task from a set of at least one incomplete task on the basis of an expected duration for that task. Therefore, it is respectfully submitted that Peters does not anticipate claim 6. The Examiner is thus respectfully requested to withdraw the rejection of claim 6, which is believed to be in condition for allowance.

If for any reason the Examiner maintains her position, the Examiner is respectfully requested to withdraw the finality of the current Final Office Action for the reasons set forth in section A of this paper and to issue a new, non-final Office Action to address the above arguments.

Dependent claims 11, 13 to 18 and 20

Claims 11, 13 to 18 and 20 are dependent on claim 6 and therefore include all the features of claim 6, including those already shown to be absent from Peters. Therefore, for the same reasons as those set forth above in respect of claim 6, it is respectfully submitted that claims 11, 13 to 18 and 20 are in condition for allowance and the Examiner is respectfully requested to withdraw the rejection of these claims.

C.3 Rejection of claim 19 under 35 USC 103

On page 4 of the Final Office Action, the Examiner has rejected claim 19 under 35 USC 103(a) as being unpatentable over U.S. Patent 6,385,637 to Peters *et al.* (hereinafter referred to as "Peters") in view of U.S. Patent 6,757,897 to Shi *et al.* (hereinafter referred to as "Shi").

The Applicant respectfully traverses this rejection and submits that claim 19 is in condition for allowance.

Firstly, claim 19 depends on claim 6 and therefore includes all the features of claim 6, including those already shown in respect of claim 6 to be absent from Peters, namely selection of an incomplete task from a set of at least one incomplete task on the basis of an expected duration for that task.

Secondly, it is respectfully submitted that, in the current Final Office Action, the Examiner has not shown Shi to teach or suggest these features of claim 6 that have been shown to be absent from Peters. In the previous Office Action (mailed September 22, 2004), the Examiner had alleged that Shi discloses these features of claim 6. However, on pages 11 and 12 of the response to the previous Office Action (filed on February 22, 2005), it was clearly shown that Shi does not teach or suggest the above features of claim 6.

Accordingly, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness since it was not shown that Peters and Shi, taken alone or in combination, teach or suggest all of the claim features[1]. The Examiner is thus respectfully requested to withdraw the rejection of claim 19, which is believed to be in condition for allowance.

C.4 Rejection of claim 21 under 35 USC 103

On page 4 of the Final Office Action, the Examiner has rejected claim 21 under 35 USC 103(a) as being unpatentable over U.S. Patent 6,385,637 to Peters *et al.* (hereinafter referred to as "Peters").

The Applicant respectfully traverses this rejection and submits that claim 21 is in condition for allowance.

Specifically, claim 21 depends on claim 6 and therefore includes all the features of claim 6, including those already shown in respect of claim 6 to be absent from Peters, namely

[1] For the Examiner to establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. MPEP §§ 706.02(j), 2142 (8th ed.).

selection of an incomplete task from a set of at least one incomplete task on the basis of an expected duration for that task.

Accordingly, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness since Peters does not teach or suggest at least one feature of claim 21 (via its dependency on claim 6). The Examiner is thus respectfully requested to withdraw the rejection of claim 21, which is believed to be in condition for allowance.

C.5 Rejection of claims 22 to 26 under 35 USC 103

On page 5 of the Final Office Action, the Examiner has rejected claims 22 to 26 under 35 USC 103(a) as being unpatentable over U.S. Patent 6,385,637 to Peters *et al.* (hereinafter referred to as "Peters") in view of U.S. Patent 5,764,992 to Kullick *et al.* (hereinafter referred to as "Kullick").

Firstly, it is respectfully submitted that the rejection of claims 23 to 26 is moot in view of the cancellation of these claims.

Secondly, as described below, the Applicant respectfully traverses the rejection of claim 22 and submits that this claim is in condition for allowance.

Independent claim 22

The Examiner's attention is respectfully directed to the following excerpt of claim 22, portions of which have been emphasized:

> A method of executing a set of incomplete tasks, comprising:

(a) removing an existing incomplete task from the set when a newer version of the existing incomplete task is added to the set;

[...].

It is respectfully submitted that Peters and Kullick, taken alone or in combination, do not disclose or suggest removing an existing incomplete task from a set of incomplete tasks when a newer version of the existing incomplete task is added to the set.

Firstly, the Examiner conceded on page 5 of the Final Office Action that Peters does not disclose removing an existing incomplete task from a set of incomplete tasks when a newer version of the existing incomplete task is added to the set.

Secondly, it is respectfully submitted that Kullick does not disclose the above feature of claim 22 already conceded by the Examiner to be not disclosed by Peters. Specifically, Kullick describes software upgrading wherein a newly-started *software program* searches for a newer version of that *software program* and then starts to execute that newer version if the search is successful (see col. 3, lines 32 to 48). A newly-started *software program* as described by Kullick is not equivalent to an "existing incomplete task", i.e. an existing task that is not yet completed. That is, the Applicant fails to see how a *software program* as described by Kullick can be considered a task that is either complete or incomplete.

Accordingly, it is respectfully submitted that Peters and Kullick, taken alone or in combination, do not disclose or suggest at least one feature of claim 22. Therefore, the Applicant respectfully submits that at least one criterion for establishing a *prima facie* case of obviousness has not been satisfied. The Examiner is thus respectfully requested to withdraw the rejection to claim 22, which is believed to be in condition for allowance.

C.6 Rejection of claims 8, 32 to 38, 40 and 41 under 35 USC 103

On page 6 of the Final Office Action, the Examiner has rejected claims 8, 32 to 38, 40 and 41 under 35 USC 103(a) as being unpatentable over U.S. Patent 6,385,637 to Peters *et al.* (hereinafter referred to as "Peters") in view of U.S. Patent 6,553,400 to Fukuda (hereinafter referred to as "Fukuda").

As described below, the Applicant respectfully traverses this rejection and submits that claims 8, 32 to 38, 40 and 41 are in condition for allowance.

Independent claim 8

The Examiner's attention is respectfully directed to the following excerpt of claim 8, portions of which have been emphasized:

> A method of executing a set of at least one incomplete task, comprising:
>
> (a) selecting an incomplete task from the set on the basis of a number of times that the task has been previously suspended;
>
> [...].

It is respectfully submitted that Peters and Fukuda, taken alone or in combination, do not disclose or suggest selecting an incomplete task from a set of at least one incomplete task on the basis of a number of times that the task has been previously suspended.

Firstly, the Examiner conceded on page 6 of the Final Office Action that Peters does not disclose selecting an incomplete task from a set of at least one incomplete task on the basis of a number of times that the task has been previously suspended.

Secondly, it is respectfully submitted that the Examiner has failed to show that Fukuda discloses the above feature of claim 8 already conceded by the Examiner to be absent from Peters. Specifically, and referring to the specific passages cited by the Examiner,

Fukuda describes tracking the number of times a program task has been resumed (see col. 2, lines 59 to 63). This is not equivalent to the number of times the program task has been suspended since a given program task can be suspended and never resumed. Furthermore, Fukuda describes presenting a list of program tasks in a format that makes it easier for a user to select a given program task to be resumed (see col. 3, lines 2 to 10). Clearly, since *the user is free to select any program task he or she wants*, Fukuda does not describe selecting a program task, let alone selecting a program task on a basis of any criterion. For these reasons, it is respectfully submitted that the Examiner has failed to show that Fukuda discloses or suggests selecting an incomplete task from a set of at least one incomplete task on the basis of a number of times that the task has been previously suspended.

Accordingly, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness since it was not shown that Peters and Fukuda, taken alone or in combination, teach or suggest all of the claim features. The Examiner is thus respectfully requested to withdraw the rejection of claim 8, which is believed to be in condition for allowance.

Dependent claims 32 to 38, 40 and 41

Claims 32 to 38, 40 and 41 are dependent on claim 8 and therefore include all the features of claim 8, including those which have not been shown by the Examiner to be taught or suggested by Peters and Fukuda, whether taken alone or in combination. Therefore, for the same reasons as those set forth above in respect of claim 8, it is respectfully submitted that claims 32 to 38, 40 and 41 are in condition for allowance and the Examiner is respectfully requested to withdraw the rejection of these claims.

C.7 Rejection of claim 39 under 35 USC 103

On page 8 of the Final Office Action, the Examiner has rejected claim 39 under 35 USC 103(a) as being unpatentable over U.S. Patent 6,385,637 to Peters *et al.* (hereinafter referred to as "Peters") in view of U.S. Patent 6,553,400 to Fukuda (hereinafter referred to as "Fukuda") and further in view of U.S. Patent 6,757,897 to Shi *et al.* (hereinafter referred to as "Shi").

The Applicant respectfully traverses this rejection and submits that claim 39 is in condition for allowance.

Firstly, claim 39 depends on claim 8 and therefore includes all the features of claim 8, including those which have not been shown by the Examiner to be taught or suggested by Peters and Fukuda, namely selection of an incomplete task from a set of at least one incomplete task on the basis of a number of times that the task has been previously suspended.

Secondly, it is respectfully submitted that the Examiner has not shown Shi to teach or suggest these features of claim 8 and thus of claim 39 which have not been shown by the Examiner to be taught or suggested by Peters and Fukuda.

Accordingly, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness since it was not shown that Peters, Fukuda, and Shi, taken alone or in combination, teach or suggest all of the claim features. The Examiner is thus respectfully requested to withdraw the rejection of claim 39, which is believed to be in condition for allowance.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the finality of the current Office Action is improper. The Examiner is thus respectfully requested to withdraw the finality of the current Office Action.

In addition, the Applicant is of the view that claims 6, 8, 11, 13 to 22, and 32 to 41 are in condition for allowance. Favourable reconsideration is requested. Early allowance of the application is earnestly solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP 707.07(j) or in making constructive suggestions pursuant to MPEP 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,
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